

REMARKS

Claims 6-23 are pending. Claim 6 is currently amended for improved clarity based on for example paragraph [0010] of the disclosure. No new matter was added.

By the Office Action, Claims 6 and dependent Claims 7-23 stand rejected under 35 U.S.C. 101, allegedly for being drawn to non-statutory subject matter, i.e., the claims define software per se.. Also, Claims 6-15, 18, 20 and 23 stand rejected under 35 U.S.C. 103 (a) over Greer et al (US Patent Application No. 20001/001226) (“Greer”) in view of Ehring et al (US Patent Application No. 2005/0097008) (“Ehring”). Further, Claims 17 and 19 stand rejected under 35 U.S.C. 103 (a) over Greer in view of Ehring and further in view of Binder (US Patent No. 6,513,052) (“Binder”); and Claims 16, 21 and 22 stand rejected under 35 U.S.C. 103(a) over Greer in view of Ehring and further in view of Istvan (US Patent Application No. 2002/0042747) (“Istvan”).

At least for the following reasons, it is believed that the claims define allowable subject matter and thus allowance is respectfully requested.

The 35 U.S.C. 101 Rejection

Claim 6, as amended, defines a system for displaying information on a user’s computer in a client-server environment. The system includes a rule-based agent operating on the computer for evaluating data using a plurality of rules. The system includes a plurality of data providers; an advertising trigger to notify the agent to begin evaluating the data; and at least one action for providing information based on the evaluated data. In the system, the action is performed provided that all the required rules and at least one of the optional rules are satisfied, and wherein at least one of the action comprises displaying a prompt associated with the targeted advertising trigger, leading to a sale.

Thus, the Applicants’ system as claimed is i) a system that is functional (e.g. it evaluates data to produce a prompt that leads to a sale); ii) it comprises structural elements,

(e.g. it includes a computer, a rules-based agent, and a trigger in a client-server environment); and it produces a tangible, concrete result (e.g. it provides information to a user that leads to a sale). Accordingly, the claimed invention is statutory and is not merely software per se; consequently withdrawal of this basis for rejecting Claims 6-23 is respectfully requested.

The 35 U.S.C. 103(a) Rejection of Claims 6-15, 18, 20 and 23

In rejecting Claims 6 - 15, 18, 20 and 23 under 35 U.S.C. 103(a), the Examiner acknowledges that Greer does not teach the Applicant's claimed invention: "wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses; and wherein an action is performed provided all the required rules clauses and at least one of the optional rule clauses are satisfied; and wherein said prompts leads to a sale".

However, according to the Examiner this deficiency in Greer is rectified by Ehring allegedly at paragraph 0013 that teaches "wherein the rules clauses comprise one or more required rules clauses and one or more optional rules clauses"; and at paragraph 0113 Ehring that teaches "wherein an action is performed provided all the required rules clauses and at least one of the optional rule clauses are satisfied"; and at paragraphs 0040 and 0144 Ehring that teaches "wherein said prompts leads to a sale". Thus, according to the Examiner, Claim 6 and dependent Claims 7-15, 18, 20 and 23 are obvious in view of Greer and Ehring.

The Applicants have carefully reviewed both Greer and the cited paragraphs in Ehring respectively submit that contrary to the Office Action, Greer and the cited sections in Ehring when taken together do not teach or suggest all the elements of Claims 6-15, 18, 20 and 23 to support a conclusion of obviousness.

Regarding, Greer, this reference besides failing to teach the elements of the Applicants' invention as the Examiner has acknowledged, also fails to teach or suggest the Applicants' invention in that Greer teaches a baseline profile stored on a content provider

(see for example, Fig. 3, step 304 and paragraph 0017). Furtherer Greer teaches the use of an agent to provide information about the target computer to the content provider where the baseline profile is created and stored. This description of Greer's system, it is submitted, is not a teaching or suggestion of the Applicants' system of a rules based agent operating on the user computer, and wherein the rules clauses comprises one or more required rules clauses and one or more optional rules clauses. Thus one skilled in the art and interested in finding a solution to the present problem would not turn to Greer for a teaching of the Applicant's invention.

Further, the assertion that Ehring, at paragraph 00013, rectifies Greer's deficiency is not apparent even after a careful reading because in Ehring at this paragraph, there is no mention or suggestion of any "rules clauses [that] comprise one or more required rules clauses and one or more optional rules clauses". On the contrary, Ehring in this paragraph merely states that its system is an automated interactive system that enables an author to build complex consumer-merchant interactions, and that the author can design content and application rules that are interpreted by the system. Nothing in this paragraph refers to or suggests the applicants' system that comprises required rules clauses and optional rules clauses.

Similarly a careful reading of Ehring at paragraph 0113 provides no teaching nor suggestion of the Applicants' invention wherein "an action is performed provided all the required rules clauses and at least one of the optional rule clauses are satisfied". On the contrary, Ehring in paragraph 0013 merely states that its rules can be coded in Boolean such that an inclusive or exclusive relationship might always display a particular content when two user conditions are met, and whereas an exclusive relationship might only select a specific object.. This mere mention of a Boolean relationship in paragraph 0013, it is submitted, is not a teaching to one ordinarily skilled in the art that could reasonably be adopted to arrive at the

Applicant's invention which specifies that an action is performed provided [i.e. only when] all the required rules clauses and at least one of the optional rule clauses are satisfied, emphasis added here.

Further, although Ehring at paragraphs 0040 and 0144 mention a possible sale as an outcome of its system, this mere coincidence of outcomes in both systems is not a teaching of all the elements of the Applicant's claimed invention either by Ehring, or rectification by Ehring of the deficiencies of Greer. Thus the combination with Greer with Ehring does not render Claims 6-15, 18, 20 and 23 unpatentable under 35 USC 103(a). Accordingly, withdrawal of the rejection of the claims under this ground is respectfully requested.

The 35 U.S.C. 103(a) Rejection of Claims 17 and 19

In rejecting Claims 17 and 19 under 35 USC 103(a), the Examiner acknowledged that neither Greer nor Ehring teaches the Applicant's claimed feature "wherein the data provider detects a speed of the user's computer hard drive". However, according to the Examiner, this deficiency is rectified by Binder for example in its Abstract, and at col. 1, lines 59-64; col. 3, lines 21-26 and col. 4, lines 24-30. Thus, according to the Examiner Claim 17 and 19 are obvious in view of Greer in combination with Ehring and Binder.

Regarding Claim 17, the Applicants have carefully examined Binder at the cited locations and cannot find any reasonable teaching or suggestion that Binder discloses a data provider that detects a speed of the user's computer hard drive. On the contrary Binder at the cited sections merely teaches that its asset profile can identify elements such as the operating system software loaded in the computer, as well as the computer hardware configuration e.g., a processor and hardware devices connected thereto. Similarly, regarding Claim 19, while Binder mentions that its asset profile is capable of identifying a software, the fact that Claim 17 and 19 depend from Claim 6 and include all the limitations therein, which as discussed

above is not taught by Greer and Ehring, Binder therefore does not rectify the deficiencies of Greer and/or Ehring. Consequently, at least for these reasons it is respectfully submitted that neither Claims 17 nor Claim 19 is obvious in view of the combination of Greer, Ehring and Binder.

The 35 U.S.C. 103(a) Rejection of Claims 16, 21 and 22

In rejecting Claim 16 under 35 U.S.C. 103 (a), the Examiner acknowledged that neither Greer nor Ehring specifically discloses the Applicants' claimed "wherein the data provider detects a level of ink in the user's printer". However according to the Examiner, Istvan discloses this feature, for example, in Fig. 12 and 13, its Abstract, and in paragraphs 0073, 0083, 0089 and 0092, i.e. Istvan teaches an idea of generating a signal when an ink level in a printer is low. Thus, according to the Examiner Claim 16 is obvious when viewed in light of the combination of Greer, Ehring and Istvan. Similarly, in rejecting Claim 21 under this heading, the Examiner alleges that Istvan at paragraphs 0008, 0009, 0076 and 0080 teaches the Applicants' claimed "wherein the action is an e-mail sent to the user", thus rendering Claim 21 obvious in light of the combined teachings of Greer, Ehring and Binder. Similarly, in rejecting Claim 22 under this heading, the Examiner alleges that Istvan in paragraphs 0068 and 0069 discloses the Applicants' "wherein the action is a link to the website presented to the user".

Regarding Istvan, the Applicants note that this reference is not concerned with the use of a rules-based engine as described in the Applicant's disclosure, but is concerned with a relatively simpler concept of providing an automatic prompting to a user when an ink refill is required in a printer connected to a communication device. In Istvan, the printer monitoring component is configured to automatically notify the user of the need for the printer refill without the use of a rules-based decision engine as set forth in the Applicant's claims. In one

embodiment of Istvan, an on-line shopping component in its system is configured to facilitate shopping for a refill on the Internet (see the Abstract).

Regarding the rejection of Claims 16, 21 and 22 under this ground, the Applicants note that besides the fact that Istvan does not teach or suggest the Applicants' Rules-Based Decision Engine, one skilled in the art would not turn to Istvan or adopt its teaching in the manner set forth in the Applicants disclosure because of the very different nature of the inventions. Further, Istvan does not rectify the deficiencies of Greer and Ehring as discussed with regards to Claim 6 from which Claims 16, 21 and 22 depends. Thus it is respectfully submitted that in view of the combined failure of Greer, Ehring and Istvan to teach or suggest the inventions as set forth in Claims 16, 21 or 22, that the Applicant's invention is not obvious in view of the combination of Greer, Ehring and Istvan.

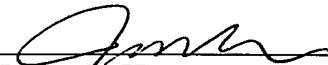
CONCLUSION

At least for the foregoing reasons, the Applicants respectfully request reconsideration of the claims, withdrawal of the rejections and allowance of the application. If a telephone conference will expedite allowance, the Examiner is kindly is requested to telephone the William P. O'Meara at (970) 898-7917.

Respectfully submitted,

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